

**REMARKS**

This Amendment is filed in response to the Office Action dated October 31, 2008.

All rejections and objections are respectfully traversed.

Claims 1 and 57 are pending in this case.

Claims 1 and 57 have been amended and are fully supported by Applicant's Specification e.g., at page 2, third full paragraph to page 3, line 4; page 6, first full paragraph; and page 14, first full paragraph.

***Request for Examiner Interview***

The Applicant respectfully requests a telephonic interview with the Examiner after the Examiner has had an opportunity to consider this Amendment, but before issuance of the next Office Action. The Applicant's undersigned attorney may be reached at 617-951-2500.

***Claim Rejections - 35 U.S.C. §103***

At paragraphs 4 – 9 of the Office Action, claims 1 and 57 were rejected under 35 U.S.C. §103(a) as being unpatentable over Baker, U.S. Patent No. 6,473,741 in view of Dang et al., U.S. Publication No. 2003/0101111.

The Applicant's claim 1, representative in part of the other rejected claims, sets forth (emphasis added):

1. A financial services outsourcing method for facilitating a direct service provider's outsourcing of financial services for numerous ultimate clients, the financial services being outsourced to an outsourcing group abroad, the method comprising:

for plural respective direct service providers, loading, onto a remotely accessible part of a common host server located in the United States, ultimate client specific financial files and corresponding reference materials, the host server providing access to a remote computer client of information concerning the ultimate client specific financial files and corresponding reference materials;

***retaining outsourced personnel to perform tax preparation services for ultimate clients of the financial services firms, the***

*outsourced personnel performing the tax preparation services while located outside the United States;*  
providing the outsourced personnel limited access to the server;  
*the outsourced personnel performing the tax preparation services through a remote limited access client located outside the United States connected to the host server;*  
*maintaining a web tracking server;*  
*reporting to the web tracking server, by the outsourced personnel, a status of the tax preparation services; and*  
*monitoring, by the financial service firms, the web tracking server to obtain the status of the tax preparation services while the outsourced personnel is performing the tax preparation services.*

By way of background, Baker discloses a system and method for the electronic exchange of tax data between those in the financial service industry. (See Baker, col. 5, lines 34 – 39). Specifically, tax preparation firms submit their databases of income tax data for archival and later retrieval by requesting organizations (“as a result of automated tax preparation, these accounting and tax firms have warehouses of databases of tax returns in digitized format,” See Baker, col. 8, lines 46 – 49). A service bureau then organizes the data from the different firms and coordinates dissemination of the data for a rental fee or user fee to third parties. (See Baker, col. 8, lines 65 – 67). Third parties then retrieve the data for the fee and utilize the data to obtain patterns and relationships that are otherwise not readily evident. (See Baker, col. 2, lines 46 – 51).

By way of further background, Dang provides a technique related to identifying and monitoring taxable transactions, and calculating taxes due on a transaction. (See Dang, paragraph [0008]). Domestic businesses are usually required by state and local authorities to charge sales and/or use tax for most commercial (i.e., sales of goods) transactions relating to goods. (See Dang, paragraph [0002]). Therefore, Dang provides a system that enables merchants to electronically outsource the burden of tax calculation and remittance to state-certified service providers. (See Dang, paragraph [0035]). Specifically, the Dang system collects data based on a financial transaction, calculates any taxes due on the transaction, reports the information to a selected government authority, and periodically remits funds corresponding to the tax owed to the government authority. (See Dang, paragraph [0018]).

First, Applicant respectfully urges that Baker and Dang, either alone or in combination, fail to teach or suggest Applicant's claimed novel "*retaining outsourced personnel to perform tax preparation services for ultimate clients of the financial services firms, the outsourced personnel performing the tax preparation services while located outside the United States*" and "*the outsourced personnel performing the tax preparation services through a remote limited access client located outside the United States connected to the host server*".

In short, Applicant claims a system and method for outsourcing tax return preparation services, while Baker discloses a system that transmits already completed tax information to third parties and Dang discloses a system that computes sales tax for merchants.

Applicant claims a system and method for outsourcing tax return preparation services. In Applicant's system, client specific financial files and corresponding reference materials are loaded on a host server. For example, the financial file may include "the last season tax return as filed, receipts and summary information regarding finances, a W-2 form, 1099 forms," etc... (See Applicant's Specification, page 3, 2<sup>nd</sup> full paragraph). Using this information, the outsource personnel can prepare the tax returns on behalf of the direct service providers.

Quite different from Applicant's claim as highlighted above, Baker merely provides tax information (i.e., already completed tax information) to third parties that utilizes the information to obtain patterns and trends (i.e., data mining). This is clearly disclosed at col. 8, lines 46 – 67 of Baker that states,

As a result of automated tax preparation, these accounting and tax firms have warehouses of databases of tax returns in digitized format...As a result of owning these data bases of taxpayer data that originate from the performance of professional accounting and tax preparation services, these data now have value if they can be organized and coordinated to capitalize on the data...a service bureau can organize all these data and coordinate dissemination of such data for a rental fee or user fee.

Therefore, the information that is provided to the service bureau is already completed tax data that is utilized for data mining. There is no disclosure in Baker of

preparing tax returns as is claimed by Applicant. Therefore, Applicant respectfully submits that Baker fails to teach or suggest Applicant's novel claim as highlighted above.

Further, Dang also fails to teach Applicant's novel claim. Specifically, Dang merely discloses a system that enables merchants to electronically outsource the burden of computing sales tax on a transaction. (See Dang, paragraph [0008]). Specifically, Dang system collects data based on a financial transaction, calculates any taxes due on the transaction, reports the information to a selected government authority, and periodically remits funds corresponding to the tax owed to the government authority. (See Dang, paragraph [0018]). The Dang publication is completely silent with respect to preparing the tax returns as is claimed by Applicant.

Further, Applicant respectfully urges that Baker and Dang, either alone or in combination, fail to teach or suggest Applicant's claimed novel *"maintaining a web tracking server"* and *"reporting to the web tracking server, by the outsourced personnel, a status of the tax preparation services"* and *"monitoring, by the financial service firms, the web tracking server to obtain the status of the tax preparation services while the outsourced personnel is performing the tax preparation services"*.

Applicant's claim a status reporting and monitoring mechanism. Specifically, as the outsourced personnel is performing the tax preparation services, the outsourced personnel can report the status (e.g., progress) of the tax preparation services to a web tracking server. Thereafter, the financial service firm (e.g. a financial firm in the United States) can obtain the status with respect to a client's tax preparation services by monitoring the web tracking server.

The Examiner suggests that Baker suggests Applicant's claimed reporting and monitoring mechanism at col. 12, lines 41 – 67 of Baker. The Applicant respectfully requests reconsideration and submits that col. 12, lines 41 – 67 of Baker merely disclose a manner in which request for already completed tax returns can be satisfied.

Specifically, col. 12, lines 41 – 67 of Baker states:

Once a valid request for data is received by the service bureau 20, the embodiment of the flow of income tax data from the tax preparation firm 10 to the ultimate end user 50,60 is described as follows. See FIG. 1.

Step A. A request for verification is faxed to the service bureau 20 organization that houses data from participating tax preparation firms 10. The request is originated by a specific taxpayer 90 who wants to have his or her taxpayer information verified to a lender, for example. This authorizing document (or electronic facsimile), known as the Transmittal from Electronic Return Originator, is processed so that the requested data is located in the service bureau 20 data warehouse and packaged or arranged in a format for download into the end users computer system. The format may simply be one currently in use or may be created to facilitate particular needs of end users.

Step B. Tax preparation firm 10 submits their databases of income tax data for archival and later retrieval by requesting organizations.... and request for bulk tax data stripped of specific identifying data to be used for data mining purposes by a variety of organizations....(Emphasis added).

Therefore, Baker says nothing of reporting a status of the tax preparation services to a web tracking server and then monitoring, by a financial firm, the status of the tax preparation service. Instead, Baker merely discloses a manner in which a requesting party can obtain already completed tax information.

Accordingly, Applicant respectfully submits that Baker and Dang, either alone or in any combination, are legally insufficient to render the present claims unpatentable under 35 U.S.C. §103 because of the absence in Baker and Dang of Applicant's claimed novel ***"retaining outsourced personnel to perform tax preparation services for ultimate clients of the financial services firms, the outsourced personnel performing the tax preparation services while located outside the United States"*** and ***"the outsourced personnel performing the tax preparation services through a remote limited access client located outside the United States connected to the host server"*** and ***"maintaining a web tracking server"*** and ***"reporting to the web tracking server, by the outsourced personnel, a status of the tax preparation services"*** and ***"monitoring, by the financial service firms, the web tracking server to obtain the status of the tax preparation services while the outsourced personnel is performing the tax preparation services"***.

***Double Patenting***

At paragraphs 10 and 11 of the Office Action, claims 1 and 57 were provisionally rejected on the grounds of nonstatutory double patenting over claim copending Application No. 10/608,651 and over claim 1 of copending Application 10/609,033.

The Applicant respectfully submits that the terminal disclaimer filed herewith on even date renders the nonstatutory double patenting rejection moot.

***Conclusion***

All independent claims are believed to be in condition for allowance.

All dependent claims are dependent from independent claims which are believed to be in condition for allowance.

Accordingly, all dependent claims are believed to be in condition for allowance.

Please charge any additional fee occasioned by this paper to our Deposit Account No. 03-1237.

Respectfully submitted,

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